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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/785,413	02/20/2001	Hiroshi Tanaka	FJ-2000-043-US	1891
21254 7590 09/07/2006 MCGINN INTELLECTUAL PROPERTY LAW GROUP, PLLC 8321 OLD COURTHOUSE ROAD SUITE 200 VIENNA, VA 22182-3817			EXAMINER MISLEH, JUSTIN P	
			ART UNIT	PAPER NUMBER
			2622	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/785,413		TANAKA ET AL.	
	Examiner		Art Unit	
	Justin P. Misleh		2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 51 - 88 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 51 - 88 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7-17-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the rejection of Claims 51 – 88 under 35 U.S.C. 112, 1st paragraph, as failing to comply with the enablement requirement have been fully considered and are persuasive. The rejection of Claims 51 – 88 has been withdrawn. Accordingly, this action is Non-Final and is meant to replace the Non-Final mailed March 14, 2006.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. **Claims 51 – 86** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Antecedent Basis (independent Claim 51)

The claim language requires therein, “an image pick-up device which picks up an image” and another “an image pick-up device which transmits an image file” (lines 8 and 13, respectively). However, line 16, requires “the image pick-up device” without specifying which one of the two previously introduced image pick-up devices it is in reference to. For at least this reason, Claim 51 lacks antecedent basis.

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The claim language requires therein, “displaying the information of the directories presented from the image pick-up device” (lines 17 and 18). However, no “image pick-up device” for presenting has previously been introduced. For at least this reason, Claim 51 lacks antecedent basis.

The claim language requires therein, “the function file name” (lines 8 – 10). However, the plural “function file names” has been previously introduced. It unclear which of the “function file names” “the function file name” refers to. For at least this reason, Claim 51 lacks antecedent basis.

Clarity and Precision (independent Claim 51)

The claim language recites the following limitation: “wherein: the information processing device comprises: an image pick-up device which transmits an image file obtained by picking up the image to the image information receiver through the communicating device; a first communicating device capable of transmitting and receiving the information to and from the image pick-up device; a display for displaying the information of the directories presented from the image pick-up device; and a selecting device which selects and designates a desired function file name showing a desired function on the basis of the displayed information of the directories.”

The Examiner submits this limitation lacks clarity and precision. Initially, the Examiner notes that “the information processing device” referred to in this limitation references the “information processing device” introduced as part of the “image pick-up information transmitting system” on line 4 of the claim. However, Applicant identifies “the information processing device” as being contained within the “electronic camera main body” (elements 44

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and 10, respectively, in figure 3; also see column 13, lines 13 and 14). Furthermore, Applicant identifies the “image pick-up device” as also being contained within the “electronic camera main body” (elements 42 and 10, respectively, in figure 3; also see column 13, lines 4 and 5). Finally, Applicant identifies the “transmitting and receiving device” as the “wireless communication device” and as also being contained in the “electronic camera main body” (elements 60 and 10, respectively, in figure 3; also see column 14, lines 17 – 19).

Therefore, based upon Applicant’s disclosure, the claim language lacks clarity and precision to the extent that the scope (metes and bounds) of the claim language cannot be determined. Essentially, second introductions of claim elements as part of a previously introduced device, wherein the secondly introduced claim elements originally belong to another device in the overall system renders the claim “vague and indefinite.”

Examiner’s Claim Interpretation (independent Claim 51)

For the purposes of examination, the will be interpreted consistent with Applicant’s disclosure and as follows:

“An image pick-up information transmitting system, comprising:

an electronic camera comprising:

a first communicating device capable of transmitting and receiving
information of directories to and from an image information receiver;

an information processing device which instructs the information of
directories in which the file names of functions indicating at least a function for
picking up an image are registered to be transmitted to the image information
receiver through the first communicating device; and

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an image pick-up device which picks up an image allocated to at least one function file name of the function file names when the image information receiver requests to transmit a file corresponding to the at least one function file name of the function file names, wherein:

the image information receiver comprises:

a second communicating device capable of receiving the information of directories from the first communicating device;

a display for displaying the information of the directories received by the second communicating device; and

a selecting device which selects and designates the one function file name of the function file name corresponding to a desired function on the basis of the displayed information of the directories.”

Dependent Claims (Claims 52 – 86)

The dependent Claims 52 – 86, by virtue of their dependency, also lack antecedent basis, clarity and precision. Additionally, the Examiner’s interpretation of Claim 51 also presents antecedent basis, clarity and precision issues. Due to the volume and complexity of the dependency of Claims 52 – 86, the Examiner will not individually point out each infraction. However, Applicant is expected to thoroughly review the dependent claims and eliminate these errors. For the purposes of examination, the Examiner will interpret Claims 52 – 86 as being fully encompassed by Claim 88.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 51 – 88** are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomat et al. (US 6,784,925 B1) in view of Kaibara (US 6,954,280 B1).

In view of the Examiner's interpretation above, Claims 51 and 87 appear to be corresponding apparatus and method claims. Accordingly, they will be rejected together. Furthermore, in view of the Examiner's interpretation above, the dependent method Claim 88 appears to fully encompass the dependent apparatus Claims 52 – 86. Accordingly, they will also be rejected together.

6. For **Claims 51 and 87**, Tomat et al. disclose, as shown in figures 1 – 3 and 22, an image pick-up information transmitting system (see figure 1), comprising:

an electronic camera (14 – see figure 1) comprising:

a first communicating device (I/O 37 – see figure 3) capable of transmitting and receiving information of directories (System Object Tree 206/208 in figure 22) to and from an image information receiver (1 – see figure 1; also see column 5, line 37 – column 6, line 34 and column 14, line 30 – column 15, line 53);

an information processing device (35 – see figure 3) which instructs the information of directories (System Object Tree 206/208 in figure 22) in which the file names of images are registered to be transmitted to the image information receiver (1)

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through the first communicating device (37; also see column 5, line 37 – column 6, line 34 and column 14, line 30 – column 15, line 53); and

an image pick-up device (31 – see figure 3) which picks up an image, wherein:
the image information receiver (1 – see figure 2) comprises:

a second communicating device (18 – see figure 2) capable of receiving the information of directories (System Object Tree 206/208 in figure 22) from the first communicating device (37);

a display (2 – see figure 1) for displaying the information of the directories (System Object Tree 206/208 in figure 22) received by the second communicating device (18); and

a selecting device (5 – see figure 1) which selects and designates an image on the basis of the displayed information of the directories (System Object Tree 206/208 in figure 22; also see column 5, line 37 – column 6, line 34 and column 14, line 30 – column 15, line 53).

Tomat et al. disclose, as stated in column 16 (line 62) – column 17 (line 5), “double clicking on a displayed thumbnail image file launches an OLE image container application and opens an associated full-resolution image file within the application ... alternatively, double clicking of a displayed thumbnail image file launches a JPEG default application specified by the system registry and opens an associated full-resolution file therein.” However, Tomat et al. do not specifically disclose wherein “file names of functions indicating at least a function for picking up an image are registered” in the directories and are also to be transmitted or picking-up “an image allocated to at least one function file name of the function file names when the image

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information receiver requests to transmit a file corresponding to the at least one function file name of the function file names,” or “selects and designates the one function file name of the function file name corresponding to a desired function.”

On the other hand, Kaibara disclose also disclose an image pick-up information transmitting system including an electronic camera and image information receiver. Specifically, Kaibara disclose, as shown in figures 4 and 11 and as stated in column 8 (line 37) – column 9 (line 10), information of directories transmitted from the camera (100 – see figure 3) to the image information receiver (308 – see figure 3), wherein the information of directories includes “file names of functions indicating at least a function for picking up an image” (see “setup.exe”, “transfer.img”, “selimage.mrk”, etc.), picking-up “an image allocated to at least one function file name of the function file names when the image information receiver requests to transmit a file corresponding to the at least one function file name of the function file names,” (“transfer.img”), and “selects and designates the one function file name of the function file name corresponding to a desired function.”

The Examiner considers the “transfer.img” function file, which Kaibara states “[represents] a program for selecting and transmitting an image is also stored in this directory” (see column 8, lines 60 – 62), to be the “function file” for picking-up an image, since it inherent to transferring the image that the image must have been previously picked-up. Accordingly, Kaibara provides the claim limitations missing from Tomat et al.

At the time the invention was made, it would have been obvious to one with ordinary skill in the art to have included the registering, transmitting, and selecting of “function file names” allocated to picking-up an image (as taught by Kaibara), in the image pick-up

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transmitting system (disclosed by Tomat et al.) for the advantage of *realizing easy confirmation of a transmitted image and to efficiently perform desired image processing* (see column 1, lines 32 – 41).

7. As for **Claims 52 – 86 and 88**, Kaibara additionally teaches, in column 14 (lines 31 – 49), a response (“Receive.mrk”) transmitted by the electronic device is a file with a description indicating the result of the operation (Kaibara states, “automatically generates a mark file ... for reception confirmation”).

Cited Prior Art

8. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure for the reason that each discloses “function file names” stored in a camera directory (Endsley et al. – see figure 6; Ito et al. – see figure 4A).

Conclusion

9. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Justin P Misleh whose telephone number is 571.272.7313. The Examiner can normally be reached on Monday through Friday from 8:00 AM to 5:00 PM.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Vivek Srivastava can be reached on 571.272.7304. The fax phone number for the organization where this application or proceeding is assigned is 571.273.3000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPM

September 5, 2006



VIVEK SRIVASTAVA
PRIMARY EXAMINER